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EXAMINER
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LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 10/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/941,432

Applicant(s)

ARNOLD ET AL.

Examiner

Etienne P LeRoux

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### *Specification*

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 1 recites "reading and analyzing said binary RDO file." One of ordinary skill in the art would not be able to make and use the invention because a binary RDO file is not clearly defined in the specification. For purposes of this Office Action, examiner interprets RDO as a rasterized data object.

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Claim 1 recites "generating an output in a selected format." One of ordinary skill in the art would not be able to make and use the invention because "selected format" is not included in the specification.

Claims 2-8 are rejected for being dependent from a rejected base claim.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "an arrangement of pages in a final document," "placing one or more bitmap files for each page onto an output page," The scope of the present invention is unclear because Applicant references page(s) in three(3) separate instances. The number of pages Applicant is claiming is unclear.

Claims 2-8 are rejected for being dependent from a rejected base claim.

Claim 22 recites "wherein said parsing function comprises the steps of:  
reading the next code;

- making a determination if said code is a leaf and, if so, said leaf data are read and stored and said process continues,
- wherein if said code is read as a directory, then a next size is read and,
- if said size read does not fit into a remaining byte size, then an error is detected and said process is aborted,

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- otherwise remaining size is reduced by a new size and said parsing function is invoked to effect recursion,
- wherein upon return, a child tree is then stored, and if a remaining size is greater than zero said process is repeated, otherwise said process terminates.” Claim 22 is not easily understandable. The following is not clear: 1) What is read after the dictionary has been read? 2) What is the size of the remaining byte size?, 3) How is the remaining size reduced by a new size?, 4) Exactly when is a child tree stored?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-12, 14-19 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,638,498 issued to Tyler et al (hereafter Tyler ‘498), as best examiner is able to ascertain.

**Claim 1:**

Tyler ‘498 discloses:

- reading and analyzing said binary RDO file [col 1, lines 47-59];
- extracting data contained within said RDO file describing an arrangement of pages in a final document [Fig 2, item 26 and col 7, lines 55-64]

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- generating an output by placing one or more bitmap files for each page onto an output page and adding optional text messages for header, footer, and page number [Fig 2, item 16 and col 8, lines 40-49]

Claim 2:

Tyler '498 discloses decoding said binary RDO file internal structure; parsing said binary RDO file; and transferring said parsed binary RDO file into a data structure representation in a memory [Fig 2, item 28 and col 8, lines 8-22].

Claim 3:

Tyler '498 discloses said extracting step further comprising: collecting data for each page in said RDO binary file, where said data are scattered throughout said RDO binary file, and where some data are page-invariant and that apply to an entire document embodied in said RDO binary file [col 6, lines 46-50].

Claim 4:

Tyler '498 discloses wherein said page-invariant data comprise font selection [col 6, lines 38-44]

Claim 6:

Tyler '498 discloses storing said output in a memory when all pages have been processed [col 5, lines 27-33]

Claim 7:

Tyler '498 discloses wherein said selected format is a PDF format [col 6, line 54-58].

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Claim 8:

Tyler '498 discloses wherein said bitmap file is a PostScript file and wherein an external, commercially available Postscript-to-PDF converter is invoked to merge these pages into an output PDF [col 6, lines 54-58].

Claim 9:

Tyler '498 discloses:

- a read module for reading and analyzing said binary RDO file [col 1, lines 47-59];
- understand module for extracting data contained within said RDO file describing an arrangement of pages in a final document [Fig 2, item 26 and col 7, lines 55-64];
- a reproduce module for generating an output by placing a bitmap file for each page onto an output page and adding optional text messages for header, footer, and page number [Fig 2, item 16 and col 8, lines 40-49].

Claim 10:

Tyler '498 discloses a decoder for decoding said binary RDO file internal structure; a parser for parsing said binary RDO file; and a memory for receiving a data structure representation of said parsed binary RDO file [Fig 2, item 28 and col 8, lines 8-22].

Claim 11:

Tyler '498 discloses a mechanism for collecting data for each page in said RDO binary file, where said data are scattered throughout said RDO binary file, and where some data are page-invariant and that apply to an entire document embodied in said RDO binary file [col 6, lines 46-50].

Claim 12:

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Tyler '498 discloses wherein said page-invariant data comprises font selection [col 6, lines 38-44].

Claim 14:

Tyler '498 discloses a memory for storing said output when all pages have been processed [col 5, lines 27-33].

Claim 15:

Tyler '498 discloses wherein said selected format is a PDF format [col 6, lines 54-58].

Claim 16:

Tyler '498 discloses wherein said bitmap file is a PostScript file [col 6, lines 54-58].

Claim 17:

Tyler '498 discloses an external, commercially available Postscript-to-PDF converter for merging said bitmap file for each of said pages into an output PDF [col 6, lines 54-58].

Claim 18:

Tyler '498 discloses wherein said output comprises an internal representation of any of the following items once all data have been gathered from said RDO file: for each page a list of images on a page [display per abstract]

Claim 19:

Tyler '498 discloses:

- reading and analyzing said binary RDO file [col 1, lines 47-59];
- extracting data contained within said RDO file describing an arrangement of pages in a final document [Fig 2, item 26 and col 7, lines 55-64];
- generating an output by placing one or more bitmap files for each page onto



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an output page and adding optional text messages for header, footer, and page number  
decoding said binary RDO file internal structure [Fig 2, item 16 and col 8, lines 40-49];

- parsing said binary RDO file into a tree data structure; and transferring said parsed binary RDO file as said tree data structure representation to a memory [col 31, lines 35-40].

Claim 21:

Tyler '498 discloses wherein said initialization function comprises the step of: reading said RDO file into a buffer, wherein a first code byte is read, a size byte is read, and said parsing function is invoked [Fig 2, item 28 and col 8, lines 8-22].

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler '498, as best examiner is able to ascertain.

Claim 24:

Tyler '498 discloses the elements of claim 19 as noted above.

Tyler '498 fails to disclose providing a separate job ticket file which specifies printing options that are not directly part of said document and that depend on capabilities of an output device; and extracting information stored in said job ticket file, which information relates to features supported by a particular device or set of devices.

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Official Notice is taken that providing a separate job ticket file which specifies printing options that are not directly part of said document and that depend on capabilities of an output device; and extracting information stored in said job ticket file, which information relates to features supported by a particular device or set of devices is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Tyler '498 per the above for the purpose of selecting user preferences such as pages of the document to be printed.

Claim 25:

Tyler '498 discloses the elements of claim 19 as noted above.

Tyler '498 fails to disclose wherein said job ticket files specifies any of number of copies of said document to be printed.

Official Notice is taken that wherein said job ticket files specifies any of number of copies of said document to be printed is well-known and expected in the art.

The ordinarily skilled artisan would have been motivated to modify Tyler '498 per the above for the purpose of creating the correct number of copies per the document distribution list.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler '498 in view of Pub No US 2003/0016233 issued to Charpentier (hereafter Charpentier '233), as best examiner is able to ascertain.

Claim 5:

Tyler '498 discloses the elements of claim 1 as noted above.

Tyler '498 fails to disclose wherein said bitmap file is a TIFF format file.

Charpentier '233 discloses wherein said bitmap file is a TIFF format file [paragraph 32]

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tyler '498 to include wherein said bitmap file is a TIFF format file as taught by Charpentier '233.

The ordinarily skilled artisan would have been motivated to modify Tyler '498 per the above for the purpose of converting a well-known file format into a format common for the document [paragraph 32].

Claim 13:

Tyler '498 discloses the elements of claim 1 as noted above.

Tyler '498 fails to disclose wherein said bitmap file is a TIFF format file.

Charpentier '233 discloses wherein said bitmap file is a TIFF format file [paragraph 32]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tyler '498 to include wherein said bitmap file is a TIFF format file as taught by Charpentier '233.

The ordinarily skilled artisan would have been motivated to modify Tyler '498 per the above for the purpose of converting a well-known file format into a format common for the document [paragraph 32].

Claims 20 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tyler '498 in view of US Pat No 5,680,622 issued to Even (hereafter Even '622), as best examiner is able to ascertain.

Claim 20:

Tyler '498 discloses the essential elements of claim 19 as noted above.

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Tyler '498 fails to disclose wherein said step of parsing said tree structure comprises an initialization function which reads said RDO binary into memory and a recursive parsing function.

Even '622 discloses wherein said step of parsing said tree structure comprises an initialization function which reads said RDO binary into memory and a recursive parsing function [col 11, lines 8-15]

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tyler '498 to include wherein said step of parsing said tree structure comprises an initialization function which reads said RDO binary into memory and a recursive parsing function as taught by Even '622.

The ordinarily skilled artisan would have been motivated to modify Tyler per the above for the purpose of quickly detecting and processing shareable information in parse trees [col 11, lines 5-7]

Claim 23:

Tyler '498 discloses the essential elements of claim 19 as noted above.

Tyler '498 fails to disclose creating a template similar to an expected subtree.

Even '622 discloses creating a template similar to an expected subtree [col 4, lines 29-41].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tyler '498 to include creating a template similar to an expected subtree as taught by Even '622.

The ordinarily skilled artisan would have been motivated to modify Tyler '498 per the above for the purpose of efficiently store parse trees that have duplicated nodes [col 4, lines 39, 40]

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Patent related correspondence can be forwarded via the following FAX number (703) 872-9306

Etienne LeRoux

October 28, 2003



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AU 2171